

REMARKS

I. Introduction

Claims 1, 3-13 and 17 are currently pending in the present application.

Reconsideration of the application is respectfully requested in view of the following remarks.

II. Rejection of Claims 1 and 3-19 under 35 U.S.C. § 103(a)

Claims 1, 3-13 and 17 stand rejected under 35 U.S.C. § 103(a). The Patent Office contends that these claims are unpatentable over U.S. Patent No. 5,424,085 ("Hsieh *et al.*") in view of U.S. Patent No. 6,207,207 ("Belzowski *et al.*"). It is respectfully submitted that the present claims are patentable over the cited references and that this rejection should be withdrawn for at least the following reasons.

To reject a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness as set out by the factors in *Graham v. John Deere*. 383 U.S. 1, 17-18 (1966); *see also In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 U.S.P.Q.2d 1329, 1335 (Fed. Cir. 2006). Further, the Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements." *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). The Examiner's "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*

The Examiner refers to the abstract to state that "Hsieh teaches nuts or seeds are coated with emulsifier." Office Action at p. 2. However, the abstract states that "individually coated nuts or seeds are produced by mixing nuts or seeds . . . with a coating syrup" and "optionally coating with . . . a protective alpha-tending emulsifier coating." Hsieh *et al.* Abstract. The alpha-tending emulsifier coating referred to by the Examiner in citing to the abstract is not disclosed as containing lecithin. Rather, the alpha-tending emulsifier, discussed at col. 6, lines 24-41 of Hsieh *et al.*, is disclosed "as distilled acetylated monoglyceride of melting temperature ranging from 99° F. to 114° F., propylene glycol esters and lactylated monoglycerides, very preferably by coating with distilled acetylated

monoglyceride of melting temperature ranging from 99° F. to 104° F., at a level of 0.5 to 2.0% based on the weight of the nuts or seeds.”

The Hsieh *et al.* disclosure relates to nuts or seeds that are coated with a coating syrup which “consists essentially of sugar and of sweetener syrup.” Hsieh *et al.*, at col. 1, lines 44-45 and col. 2, lines 60-61. The coating syrup is disclosed as being applied in a “weight ratio of nuts or seeds to coating syrup ranging from 2:1 to 9:1.” Hsieh *et al.*, at col. 1, lines 42-44. Thus, Hsieh *et al.* disclose that the coating syrup is always present in a weight that is lower than that of the seed or nut by at least 50%. The coating may optionally contain “from 0.1 to 10% by weight (on a total coating syrup basis) of emulsifier (e.g., lecithin).” Hsieh *et al.*, at col. 3, lines 13-15. Thus, if any lecithin were present in the coating of Hsieh *et al.*, it would be present in an amount of 10 % or less by weight of the coating syrup. Lecithin is also mentioned as an emulsifier for a separating component (*see* col. 5, line 15 to 25). The amount of such an emulsifier is limited to a maximum of 2% based on the weight of the seeds or nuts.

Sugar and sweetener syrup are very different substances than lecithin and have a different nature than lecithin. A coating composed predominantly of lecithin, as in the present invention, is different from a coating according to the disclosure of Hsieh *et al.* A coating formed with lecithin present in an amount greater than about 50% by weight has different characteristics than the known sugar based coatings of Hsieh *et al.* When read as a whole, Hsieh *et al.* would teach away from the presently claimed invention.

The presently claimed invention recites that the coating comprises at least one of lecithin and a lecithin derivative “wherein the lecithin and/or lecithin derivative is present in an amount greater than about 50 percent by weight of the coating.” Hsieh *et al.* does not disclose or suggest a coating that contains greater than about 50 percent by weight of lecithin or lecithin derivative. Rather, to the extent that a coating disclosed by Hsieh *et al.* contains any lecithin at all, it is limited to a very small percentage of the coating composition, and far below the presently claimed value of greater than about 50 percent.

The presently claimed invention also recites that “the weight of the coating is greater than the weight of the plant natural product.” Hsieh *et al.* does not disclose or suggest a coating that is present in weight greater than the nut or seed. No coating disclosed in Hsieh *et al.* is present in an amount greater than the weight of the nut or seed. Rather, Hsieh *et al.*

disclose that the coating syrup is always present at a weight that is lower than that of the seed or nut by at least 50%.

The disclosure of Belzowski *et al.* is limited to coating a starch-based center with a sugar shell. The starch based formed center may be a grain. All of the examples are directed to starch-based centers which are formed from specially treated products. The treatments may be an extrusion, gun puffing or vacuum oven expansion. The use of lecithin in a coating is not disclosed by Belzowski *et al.* Belzowski *et al.* does not disclose or suggest a coating comprising a lecithin or lecithin derivative or that the lecithin and/or lecithin derivative is present in an amount greater than about 50 percent by weight of the coating.

Thus, neither Hsieh *et al.* nor Belzowski *et al.* disclose or suggest a "coating comprising at least one of lecithin and a lecithin derivative and wherein the lecithin and/or lecithin derivative is present in an amount greater than about 50 percent by weight of the coating; wherein the weight of the coating is greater than the weight of the plant natural product." Applicants respectfully submit that the prior art cited by the Examiner, alone or in combination, fails to disclose or suggest each element of the presently pending claims.

Also, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness. Specifically, the Examiner has not stated any specific rational that would lead a person of ordinary skill in the art to the claimed food additive having the specified coating. The Examiner states that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a composition comprising weight of the coating is greater than the weight of the plant material for the following reasons. The reference does teach the composition for coating plant seeds. Thus, it would have been obvious to make a concentrated composition containing weight of the coating greater than the weight of the plant product for use to coat a seed.

Office Action at p. 4. Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). The Examiner has provided no rational as to why a person of ordinary skill in the art would both (i) use a coating having lecithin and/or lecithin derivative in an amount greater than about 50 percent by weight of the coating when the cited reference discloses no more

than 10 percent by weight of lecithin in a coating; and (ii) use a weight of the coating that is greater than the weight of the plant natural product when the cited reference discloses a weight ratio of coating syrup to nuts or seeds of no more than 1:2 by weight.

The Examiner further states that:

Additionally, the amount of a specific ingredient in a composition that is used for a particular purpose (the composition itself or that particular ingredient) is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, optimization of general conditions is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add to best achieve the desired result, especially within the ranges taught by the reference.

Office Action at p. 4. Again the Examiner identifies no rational or motivation that would lead to the claimed subject matter from the cited references. The Examiner’s general assertion that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art at the time the claimed invention was made is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine or modify the teachings of the references. MPEP 2143.01(IV).

For the reasons discussed above, Applicant respectfully submits that the presently pending claims are patentable over Hsieh *et al.* or Belzowski *et al.*, alone or in combination, and respectfully request that the rejection of the claims under 35 U.S.C. 103 be withdrawn.

III. Conclusion

For the preceding reasons, Applicant respectfully submits that the pending claims are in condition for allowance and requests that such action be taken. If for any reason the Examiner believes that prosecution of this application would be advanced by contact with the Applicant’s attorney, the Examiner is invited to contact the undersigned at the telephone number below.

Application Serial No. 10/660,909
Response to the Office Action dated 2/24/10

Respectfully submitted,

Date: May 12, 2010

By: 

Richard M. Rosati
Reg. No: 31,792
KENYON & KENYON LLP
One Broadway
New York, NY 10004
Tel: (212) 425-7200
Fax: (212) 425-5288
CUSTOMER NO. 26646